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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,161	04/26/2001	Hidetaka Iwai	206580US0	6889

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,161

Applicant(s)

IWA ET AL.

Examiner

Gina C. Yu

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 30, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of Amendment filed on April 30, 2002. Claims 1-20 are pending. Claim rejections under 35 U.S.C. § 112 and objection indicated in the previous office action dated January 30, 2002, are withdrawn in view of claim amendments made by applicants. Claim rejections under § 103 are maintained, except for the rejection in view of Cook, which is withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-4 and 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu (English Translation of JP 63-126542 provided herewith).

Rejection is maintained for reasons of record as indicated in the previous office action dated January 30, 2002.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu as applied to claims 1-4 and 6-20 above, and further in view of Drapier et al. US 6121228 ("Drapier").

Rejection is maintained for reasons of record as indicated in the previous office action dated January 30, 2002.

Response to Arguments

Applicant's arguments filed on April 30, 2002 have been fully considered but they are not persuasive.

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Applicants argue that Yu provides no expectation of success in obtaining stable microemulsions comprising more than 10 parts of oily phase per 1 part hydrophilic surfactants. However, examiner views that the reference does not necessarily teach away from the instant invention as applicants assert. The instant claims recite the oil phase/hydrophilic surfactant ratio of merely more than 10:1, which, in view of Yu, appears to lack patentable distinction from the prior art. As stated in the previous office action dated January 30, 2002, optimization of weight amount is presumed to be an obvious variation of a prior art in absence of evidence indicating contrary.

Applicants also assert that Yu fails to teach that an o/w emulsion according to the present invention would have transparency at 550 nm of 50 % or more. Examiner notes that, based on the teaching that the microemulsion in the prior art is inherently transparent, there is a valid presumption that a microemulsion with an obvious variation would have also resulted in a transparent composition, in absence of evidence to the contrary.

Applicants further assert that Yu fails to suggest applying a sheer rate of 10,000 s^{-1} or more to produce the emulsion. Examiner notes that the instant claims are product-by-process claims, for which patentability of a product does not depend on its method of production. See MPEP 2113. The recitation in instant claims which are directed to the process of making the emulsion does not render a structural limitation to the claimed microemulsion itself. Nonetheless, examiner notes that the reference does provide general teaching that the microemulsion is obtained by employing "high-pressure homogenizer" under specific condition to generate a high sheer rate.

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Examiner asserts that there is a valid presumption that it would have been obvious to a skilled artisan that the “shear rate of $10,000 \text{ s}^{-1}$ or more” is a resulting measurement of the shear force obtained according to the method taught in the prior art.

While applicants argue that Ansel lacks teaching of a microemulsion having the oil and nonionic surfactant ratio of more than 10:1, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Ansel has been cited merely to show that surfactants having HLB value of 8-18 inherently generate oil-in-water emulsions.

Applicants further argue that Drapier fails to teach the present invention, as the reference lacks o/w emulsions having oil and nonionic surfactants in 10:1 ratio. In response, Drapier has been cited to show that the claimed viscosity of a microemulsion would have been obvious to a skilled artisan.

Nothing unexpected or nonobvious is seen combining components well known in microemulsion art. MPEP § 718.02.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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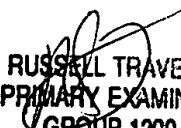
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
July 10, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200